REMARKS

The Applicants have amended claim 10 to correct a typographical error. The term "by updated" has been amended to "updating". The Applicants submit that no new subject matter was introduced by this amendment.

The Applicants thank the Examiner for his examination of the subject application thus far. The Applicants submit that the claims, as previously amended, are patentable over the cited prior art for the following reasons:

Claims 1 through 9 are not directed to statutory subject matter

The Examiner rejected claims 1-9 under 35 U.S.C. 101 as being directed to non-statutory subject matter. The Applicants note that this is the first time such a rejection has been raised during the prosecution of this application.

In the Detailed Action dated June 11, 2008 ("Detailed Action"), the Examiner premised the rejection on the basis that:

> Claims 1-9 disclose a "program product" *embodied within a modulated carrier medium* which does not fall within at least one of the four categories of patent eligible subject matter recited in 35 U.S.C. 101 (process, machine, manufacture, or composition of matter). (Detailed Action, paragraph 1, emphasis added).

However, the impugned claims recited (as was set out explicitly in independent claim 1):

> the program product comprising a medium having executable program code embodied in said medium

There was no recital of a "modulated carrier" medium. Rather, claims 1 to 9 recited a medium, and "executable program code *embodied in said medium*" (emphasis added). Thus, these claims were directed to statutory subject matter under 35 U.S.C. 101, being either a composition of matter or manufactured product.

In order to clarify the physical nature of the medium the applicant has amended claim 1 so that it

is now directed to "A program product medium comprising executable program code," which the Applicants submit is clearly statutory subject matter.

Claims 1, 2, 5-8, 10, 11, and 14-17 are patentable over the cited art

The Examiner rejected claims 1, 2, 5-8, 10, 11, and 14-17 under 35 U.S.C. 103(a) as being unpatentable over Schmidt Jr. et al. (US6778642) ("Schmidt, Jr.") in view of Keyworth II et al. (US 5579472) ("Keyworth") and DeCarmo (USPA 20040010808) ("DeCarmo"). The Applicants respectfully traverse this rejection.

Claims 1 and 10 are patentable over the cited art

As the Examiner rejected claims 1 and 10 under the same rationale (Detailed Action, page 5), these claims are addressed together. The Applicants disagree that these claims are unpatentable.

The cited art does not disclose all of the features of claims 1 and 10

None of the art cited by the Examiner discloses a communications device "capable of executing a plurality of message applications" and a "program product comprising a medium having executable program code... for dynamically retrieving heterogeneous messages" and "to continually retrieve messages as they are received... and to *display retrieved messages that match the at least one collating criterion, the retrieved collated messages then incorporated into the application's display*" (emphasis added).

Schmidt Jr. discloses a "Unified Messaging System" that permits the viewing of a variety of messages through a single UMS server 340 (col. 5, ln 38-48). The messages may be displayed in a single heterogeneous list identifying Subject, Sender and Date (Figure 5), or they may be segregated by messaging application type: e-mail, fax or voicemail (Figures 6, 7 and 8).

At best, Schmidt Jr. is a display tool that simply acts as a store by passively receiving all types of messages and storing them for later retrieval (col. 5, ln 38-48). Schmidt Jr. does not disclose "continually selecting, using the at least one collating criterion, messages as they are received and stored by each of the communications channels while the collating application continues to display the single view at the user interface" or "updating the single view display comprising an

ordered list, by the collating application, updating the ordered list using message body fragments derived from the continually selected messages". Further, as admitted by the Examiner, Schmidt Jr. does not disclose "executing a plurality of message applications, each message application associated with a communications channel."

Keyworth II purports to disclose a "group-oriented communications user interface". However, Keyworth II does not disclose "updating the single view display comprising an ordered list, by the collating application, updating the ordered list using message body fragments derived from the continually selected messages".

DeCarmo purports to disclose a "message notification priority scheme based on a message recipient's preferences" (DeCarmo, Abstract) and suggests as desirable "allow[ing] the user to participate in instant messaging without unnecessarily distracting the user from the interactive video/multimedia experience" (paragraph [0005]). DeCarmo is thus directed only to a single message type, the instant message, and does not disclose handling more than one type of messaging application. DeCarmo does not disclose "continually selecting, using the at least one collating criterion, messages as they are received and stored by each of the communications channels while the collating application continues to display the single view at the user interface" or "updating the single view display comprising an ordered list, by the collating application, updating the ordered list using message body fragments derived from the continually selected messages". DeCarmo is only concerned with the urgency of an instant message, and specifically directs the reader *away* from "displaying... an ordered listing of body fragments". At best, DeCarmo discloses that only a single message is displayed at any time, not an "ordered listing" of any sort.

The Applicants further submit that none of the cited art discloses "continually selecting, using the at least one collating criterion, messages *as they are received and stored* by each of the communications channels..." (emphasis added). Schmidt Jr. teaches the use of a central UMS store 340. Keyworth II only discloses that the user may utilize data storage unit 22 to designate a select group of individuals to have their communications handled in a preferred manner (col. 4, ln 1-13). DeCarmo only deals with instant messaging and does not discuss whether messages are stored at all.

All the claim limitations must be taught or suggested by the prior art for a rejection on the basis of obviousness to be made out: *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). Therefore, claims 1 and 10 must be patentable over the cited art.

There is no appropriate basis for the combinations of the cited art

The Applicants submit that no proper basis for combining Keyworth II with either of the other prior art references has been provided in the Detailed Action. On page 4 of the Detailed Action, it is stated that one "would have been motivated to provide [the functionality of Keyworth II] in Schmidt because it provides an interface that is intuitive, efficient and user friendly". However, the prior art cited must suggest the desirability of the combination, not only its feasibility or the desirability of its own teachings: *In re Fulton*, 73 USPQ2d 1141, 1145 (Fed. Cir. 2004).

Furthermore, the Applicants submit that no proper basis for combining DeCarmo with either of the other prior art references has been set out in the Detailed Action. DeCarmo is directed only to one type of messaging application, instant messaging, and as noted above DeCarmo specifically directs the reader to the display of a single message at a time, not towards "displaying... an ordered listing of body fragments". It would not have been apparent to one of ordinary skill in the art to modify other prior art relating to a heterogeneous communications interface with DeCarmo, a single-purpose and single-type message notification scheme for displaying a single message at a time. The mere display of a portion of a single prioritized instant message body, as disclosed in DeCarmo, does not make DeCarmo relevant to the other cited art.

In addition, the Applicants submit that the proposed motivation given in the Detailed Action for combining DeCarmo with the other references mischaracterizes the teachings of DeCarmo. On pages 4-5 of the Detailed Action, it is stated that it would have been obvious to "provide body fragments in the modified Schmidt as taught by DeCarmo" because one would have been motivated "to provide the body fragment to allow the user to promptly decide the urgency of the message". What DeCarmo purports to teach, however, is that the "urgency" of an instant message is determined by user-set preferences, not by a message fragment (for example, see paragraph [0043] of DeCarmo, which states that "[t]hose who are buddies may have notification preferences of 'urgent'..."). The lack of a proper explanation of a motivation to combine the

teachings of the cited art creates an inference that hindsight was improperly used to conclude that an invention was obvious: *KSR International Co.* v. *Teleflex Inc.*, 127 S.Ct. 1727 at 1742; *In re Kahn*, 441 F.3d at 986 (C.A. Fed. 2006). Although an obviousness analysis may not require the identification of precise teachings directed to the specific subject matter of the claims, it should still articulate explicit reasons to support a legal conclusion of obviousness: *KSR, supra,* citing *In re Kahn*, 441 at 988.

Thus, for these further reasons, the Applicants submit that claims 1 and 10 are patentable over the cited art.

Since the cited art fails to render claims 1 and 10, all the dependent claims are nonobvious as well. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988).

In addition, the dependent claims are patentable for the following reasons:

The cited art does not disclose all of the features of claims 2 and 11

Keyworth II does not disclose "the specification of the at least one collating criterion". The section of Keyworth II identified by the Examiner allows a user to identify a sender as being a "VIP". VIP designated senders are collected in a single display, as seen in Figure 3 of Keyworth II. The designation of a sender as a "VIP" does not affect the collation and display of message body fragments as messaging applications receive and store messages.

The cited art does not disclose all of the features of claims 7, 8, 16 and 17

None of the cited art discloses "selection between alternative views for presenting the ordered listing of message body fragments associated with each of said retrieved messages", with respect to claims 7 and 16, or "displaying the messages in sub-lists under displayed headings, each heading reflecting the communications channel on which the said retrieved messages in the associated sub-list were received by the communications device", with respect to claims 8 and 17, inasmuch as none of the cited art discloses the "ordered listing of message body fragments".

Claims 3, 4, 12 and 13 are patentable over the cited art

The Examiner rejected claims 3, 4, 12 and 13 under 35 U.S.C. 103(a) as being unpatentable by Schmidt Jr., Keyworth II, and DeCarmo in further view of Dong (US 6571275) ("Dong"). The Applicants respectfully traverse this rejection.

The combination of this collage of references is improperly premised on hindsight.

No proper basis has been given for the alleged combination of Dong with Schmidt, Jr., Keyworth II and DeCarmo. In paragraph 4 of the Detailed Action, it is stated that "[o]ne would have been motivated to provide an address book to provide improved query of names, groups, etc.; therefore the system is more efficient and user-friendly". This rationale is so general that it could be applied to just about any reference, and has no application to the specific technical considerations of the current application. A motivation to combine references must *clearly and particularly* lead a person of ordinary skill in the art to make the combination (see *Ruiz* v. *A.B. Chance Co.*, 234 F.3d 654, 660 (Fed. Cir. 2000)). In the present Detailed Action, the fact that address books are apparently desirable in general is not proof that a skilled worker in the field would have combined the teachings of Dong with those of Schmidt, Jr., Keyworth II and DeCarmo. Furthermore, it remains unclear how it would be obvious to combine either Dong or DeCarmo, each directed to a single messaging application, with Schmidt Jr. and Keyworth II which are directed to displaying messages received from a plurality of messaging applications.

None of these four references discloses a "collating application... for *dynamically retrieving* heterogeneous messages *stored* by a plurality of message applications" (emphasis added). Schmidt Jr. and Keyworth II are directed towards communications interfaces for *receiving* communications from communications applications (Schmidt Jr. col. 5, ln 37-49; Keyworth II col. 4 ln 1-13, 30-41); it is only described that their interfaces *receive* the messages. DeCarmo is directed towards filtering instant messages. Dong is directed towards filtering display of email messages. None of the references disclose a plurality of message applications storing messages or "dynamically retrieving" the stored messages as recited in the pending claims.

Further, *none* of these four references disclose "an ordered list of message body fragments" as recited in the pending claims.

All claim limitations must be present in the prior art if an obviousness rejection is to be supported: *In re Royka, supra.* In addition, reasoned argument and evidence must be provided to show that there was a basis for combining features from the cited references: *In re Lee*, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002); without such a rationale underpinning, the implication is that the combination is premised on hindsight, which is impermissible: *KSR, supra.* Thus, for these reasons, the Applicants submit that no *prima facie* case of obviousness has been made out against these claims.

Claims 9 and 18 are patentable over the cited art

The Examiner rejected claims 9 and 18 under 35 U.S.C. 103(a) as being unpatentable over Schmidt, Jr., Keyworth II, DeCarmo and further in view of Schnarel et al. (US 7225409) ("Schnarel"). The Applicants respectfully traverse this rejection.

No proper basis has been given for the alleged combination of Schnarel with Schmidt, Jr. and/or Gidwani. In the Detailed Action, it is stated that "[o]ne would have been motivated to provide the selection capabilities to the interface because it provides complete operability, is efficient and user friendly". This rationale, as before, is so general that it could be applied to just about any reference, and has no application to the specific technical considerations of the present application. Following this logic, any reference could be combined with another reference to provide "complete operability". A motivation to combine references must *clearly and particularly* lead a person of ordinary skill in the art to make the combination (see *Ruiz* v. *A.B. Chance Co.*, 234 F.3d 654, 660 (Fed. Cir. 200)). The Examiner has not articulated a motivation to combine the references, only that the result has additional functionality. As noted above, some of the references are directed towards displaying multiple communications in a single display while others, such as DeCarmo, are directed towards filtering communications received by a single communications application to remove unwanted communications. The Examiner has provided no basis or rationale supported by the descriptions for combining these disparate technologies.

The Applicants further note that Schnarel fails to disclose "an ordered list of message body fragments" or "collating application… for dynamically retrieving heterogeneous messages stored

by a plurality of message applications" as recited in the pending claims. Thus, for reasons similar to those set out above, the Applicants submit that these claims are patentable over the cited art.

Executed at Toronto, Ontario, Canada, on September 9, 2008.

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